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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/558,884	11/29/2005	Joerg Fuchslocher	PUS-S011-001N	6123

51184 7590 10/07/2011
MOETTEL & ASSOCIATES SARL
ST. LEONHARDSTRASSE 4
ST. GALLEN, CH-9000
SWITZERLAND

EXAMINER

PRANGE, SHARON M

ART UNIT	PAPER NUMBER
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3765

MAIL DATE	DELIVERY MODE
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10/07/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/558,884	Applicant(s) FUCHSLOCHER ET AL.	
	Examiner SHARON M. PRANGE	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 3 and 6-16 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 3 and 6-16 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/24/211 has been entered.

Claims 17-36 have been canceled and claims 3 and 6-16 remain pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 10-12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackinsky (US 6,785,984) in view of Durand (US 7,155,845).

Jackinsky discloses a shoe having a sole portion (sole 16) having a ground-contacting surface, a forefoot region, a midfoot region, and a heel portion. The forefoot region of the sole has a curved form (column 3, lines 58-65; Fig. 1). The forefoot region has a thickness greater than the thickness of the heel portion (column 4, lines 45-51; column 5, lines 45-47). The differing thicknesses define an angle of declination (γ) from the forefoot region to the heel portion. The angle of declination is preferably 5 degrees (column 7, lines 20-27; Fig. 1). An insert (section 20g) is disposed in the forefoot region and is made of a higher density material. The heel portion is made of a lower density material.

Jackinsky does not disclose ribs on the insert which pass through the sole to present an exposed surface. Durand teaches attaching an insert (2) to a sole by providing ribs (lugs 3) which pass through the sole and present an exposed surface (Fig. 3, 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to have attached the insert with ribs passing through the sole, as taught by Durand, as this would be a simple substitution of one way to attach an insert to a sole for another, with the predictable result of providing a secure attachment while increasing the rigidity of the outer sole in the forefoot region. It further would have been obvious to provide the insert in a different color than the sole, as this would be a change in the aesthetic design. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

The combination of Jackinsky and Durand discloses the general conditions of the claimed invention except for the express disclosure of the hardness of the insert. It

would have been obvious to one having ordinary skill in the art at the time the invention was made to make the shore hardness of the insert and ribs between 20 and 90, since the claimed values are merely an optimum or workable range. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackinsky and Durand, as applied to claims 10-12, 14, and 15, further in view of Borgeas (US 3,990,159).

The combination of Jackinsky and Borgeas does not disclose that the sidewall portions of the sole extend upwardly to a circumferential edge which is higher in the heel region than the forefoot region. Borgeas teaches a shoe having a sole portion which increases in thickness from the heel portion to the forefoot region. A sidewall portion (ridge 16) extends upwardly to form a circumferential edge. The edge rises higher above the heel portion than the forefoot region (Fig. 8, 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided sidewall portions to the outsole which are higher in the heel portion, as taught by Borgeas, in order to help hide the thickness of the forefoot portion, providing the outside of the shoe with a more standard appearance.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackinsky and Durand, as applied to claims 10-12, 14, and 15, further in view of Carlson et al. (US 6,362,387), herein Carlson.

The combination of Jackinsky and Durand does not disclose a reinforced, padded toe portion. Carlson teaches providing padding (patches 86, 88, 100) in the toe portion of the shoe in order to decrease friction and increase comfort for the wearer (column 7, lines 58-67; column 8, lines 1-43; Fig. 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided padding in the toe portion, as taught by Carlson, in order to improve comfort for the wearer.

7. Claims 7-10, 12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daswick (US 4,241,523) in view of Durand and Jackinsky.

Daswick discloses a shoe having a sole portion having a ground-contacting surface, a forefoot region, a midfoot region, and a heel portion. An insert (base B with main rocker Rm) is disposed in the forefoot region. The insert has a straight portion (30) extending from the heel portion to the forefoot region and a curved portion (rocker Rm) curving upward in the forefoot region. The insert extends from the forefoot region to the heel portion (column 3, lines 28-68; column 4, lines 1-53; Fig. 1).

Daswick does not disclose ribs on the insert which pass through the sole to present an exposed surface. Durand teaches attaching an insert (2) to a sole by providing ribs (lugs 3) which pass through the sole and present an exposed surface (Fig. 3, 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to have attached the insert with ribs passing through the sole, as taught by Durand, as this would be a simple substitution of one way to attach an insert to a sole for another, with the predictable result of providing a secure attachment while increasing the rigidity of the outer sole in the forefoot region.

The combination of Daswick and Durand does not disclose the hardness of the insert. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the shore hardness of the insert and ribs between 20 and 90, since the claimed values are merely an optimum or workable range. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

The combination of Daswick and Durand does not disclose that the forefoot region of the sole has a curved form which has a thickness greater than the thickness of the heel portion. Jackinsky teaches a shoe having a sole portion (sole 16) having a ground-contacting surface, a forefoot region, a midfoot region, and a heel portion. The forefoot region of the sole has a curved form (column 3, lines 58-65; Fig. 1). The forefoot region has a thickness greater than the thickness of the heel portion (column 4, lines 45-51; column 5, lines 45-47). The differing thicknesses define an angle of declination (γ) from the forefoot region to the heel portion. The angle of declination is preferably 5 degrees (column 7, lines 20-27; Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a greater thickness in the forefoot region, as taught by Jackinsky, in order to encourage proper posture of the wearer with a slight forward lean.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daswick, Durand, and Jackinsky, as applied to claims 7-10, 12, 15, and 16, further in view of Rudy (US 4,506,460).

The combination of Daswick, Durand, and Jackinsky does not disclose slits in the insert. Rudy teaches providing a hard, high-density insert (moderator 16) in the forefoot region of a shoe sole. The insert has a slits (cut-out sections 23, 24) to define the bending moment of inertia (column 2, lines 38-45; column 10, lines 20-53; column 11, lines 25-31; Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided slits, as taught by Rudy, to the insert in order allow for greater flex of the insert during walking movement.

Response to Arguments

9. In view of Applicant's amendment, the search has been updated, and new prior art has been identified and applied. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON M. PRANGE whose telephone number is (571)270-5280. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoa Huynh can be reached on (571) 272-4888. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. P./ 10/03/11
Examiner, Art Unit 3765

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3765